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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOUNG JAE JEON

Appeal 2009-006979¹
Application 10/777,655
Technology Center 2400

Decided: December 24, 2009

Before KENNETH W. HAIRSTON, JOHN C. MARTIN, and CARL W.
WHITEHEAD, JR., *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is LG Electronics Inc.

STATEMENT OF THE CASE

Appellant filed a notice of appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-5 and 7-31, which were all of the claims pending at that time, under 35 U.S.C. § 103(a). In an "Amendment Under 37 CFR § 1.116" received September 5, 2007, and approved for entry in an Advisory Action mailed October 17, 2007, Appellant revised independent claims 1, 9, and 15 to include the limitations recited in respective dependent claims 7, 14, and 27, and canceled those claims. Consequently, the only claims now before us are claims 1-5, 8-13, 15-26, and 28-31.

Oral argument was heard on December 3, 2009.²

We have jurisdiction under 35 U.S.C. § 6(b). We reverse and enter a new ground of rejection.

A. *Appellant's invention*³

Appellant's invention is a home network system and a method of providing the operation history for a home network system. Specification ¶ 0002.

² "[A]rguments not presented in the brief or reply brief and made for the first time at the oral hearing are not normally entitled to consideration." MPEP § 1205.02 (8th ed., rev. 7, July 2008) (citing *In re Chiddix*, 209 USPQ 78 (Comm'r Pat. 1980)).

³ References herein to Appellant's Specification are to the Application as filed rather than to corresponding Patent Application Publication 2004/0162884 A1.

In the “Discussion of the Related Art” portion of the “Background of the Invention” (*id.* ¶¶ 0003-0006), Appellant explains that “[i]n general, a typical home network system includes a master device and a plurality of slave devices,” that “some of the typical master devices are a television (TV) receiver, a personal computer (PC) and an Internet-ready refrigerator,” and that “[t]he master appliances have a memory for sharing information with slave [sic: slave⁴] devices connected in a network.” *Id.* ¶ 0004. The “Discussion of the Related Art” also describes a BLOCK function as follows:

⁴ This typographical error was corrected by an “Amendment in Response to Non-Final Office Action” received July 7, 2005, at 2.

In such [a] home network system, when a slave device receives a status request signal from the master device, it always sends a response signal (e.g., a message or event signal) back to the master device. Therefore, when a large number of slave devices are connected to the network and are in operation, the master device may have problems in properly receiving and displaying all the message or event information sent by all the slave devices. Due to this reason, a user may be greatly disturbed when trying to use or operate the master device. One of the known functions for eliminating this overload problem is a BLOCK function, which may be activated in the master device for not displaying (blocking) the message signals sent by the slave devices for a predefined period of time. Therefore, it is impossible for a user to view or check the messages which are sent by the slave devices during the time the BLOCK function was activated.

Id. ¶ 0005. The master devices of the existing home network systems do not store any messages or data received from the slave devices. *Id.* ¶ 0006. As a result, a user is unable to check previous operation history data of the slave devices. *Id.*

Appellant's Figure 1 is reproduced below.

FIG. 1

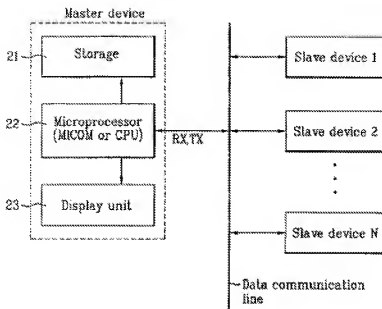


Figure 1 illustrates a home network system according to Appellant's invention. *Id.* ¶ 0016. The home network system includes a plurality of slave devices and a master device operatively connected to the slave devices. *Id.* ¶ 0019. Some of the examples of the slave devices are an electric rice cooker, a refrigerator, a heat oven, a microwave oven, and an air conditioner. *Id.* The master device can be an electrical device having data display and user interface capabilities, such as a television (TV) receiver, a refrigerator with a display panel, a personal computer (PC), or a personal data assistant (PDA) device. *Id.*

Appellant's Figure 2 is reproduced below.

FIG. 2

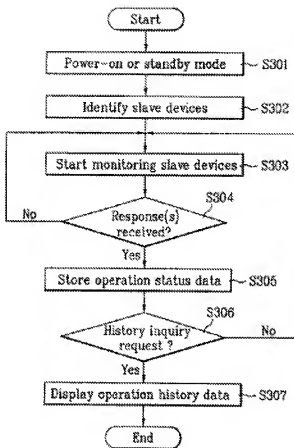


Figure 2 illustrates Appellant's method of providing an operation history for a home network system. *Id.* ¶ 0017.

In step 301, the master device connected to the home network system may be set to Power-on Mode or Standby Mode. *Id.* ¶ 0023. After all the slave devices in the network are identified by the microprocessor 22 (Fig. 1) in step S302, the microprocessor starts monitoring the slave devices by sending status request signals to the slave devices, respectively, in step

S303. *Id.* ¶¶ 0024, 0025. A response signal sent by a slave device may include data (e.g., a message) indicating the current operation status (or condition) of the slave device. *Id.* If it is determined in step S304 that any response signal is received from the slave devices, the microprocessor 22 stores the operation status data included in each response signal in the storage (e.g., a memory) 21 of the master device in step S305, regardless of whether the BLOCK function of the master device is currently activated or not. *Id.* ¶ 0026. The BLOCK function, as noted above, prevents any message sent by each slave device from being displayed on the display unit 23 of the master device when the message is received. *Id.* ¶ 0022.

When, in step S306, a user makes a request for accessing to the operation history data stored in the storage 21, the user can select one or more options for selecting the portion of the operation history data he or she wishes to access (view). *Id.* ¶ 0029.

B. The claims

The independent claims before us are claims 1, 9, and 15, of which claim 1 is reproduced:

1. A home network system comprising:
at least one slave device; and
a television receiver operatively connected to the at least one slave device, the television receiver comprising:
a microprocessor operatively connected to the at least one slave device for repeatedly sending a status request signal to the

at least one slave device and receiving one or more response signals from the at least one slave device;

a memory coupled to the microprocessor for constructing an operation history database by cumulatively storing operation status data of the at least one slave device included in each response signal, wherein the microprocessor extracts data from the operation history database when a history inquiry request is received from a user; and

a display unit coupled to the microprocessor for displaying the extracted operation history data,

wherein (1) the operation status data includes data related to specific functions performed by the at least one slave device, (2) the television receiver includes a capability to activate a message BLOCK function which prevents messages sent from the at least one slave device from being displayed, and (3) the memory cumulatively stores the operation status data included in each response signal even when the message BLOCK function of the television receiver is currently activated.

Claims App. (Br. 31). The subject matter added by amendment to claim 1 from claim 7 consists of the “BLOCK function” limitations recited in the “wherein” clause. “Amendment Under 37 CFR § 1.116,” received Sept. 5, 2007, at 2.

C. The references

The rejections are based on the following references:⁵

Klosterman et al. (“Klosterman”) US 2002/0092017 A1 Jul. 11, 2002

⁵ Because the availability of the references as prior art against Appellant’s claims is not at issue, only the issue or publication dates are being provided. (Continued on next page.)

Smyers	US 6,430,629 B1	Aug. 6, 2002
Dara-Abrams et al. (“Dara-Abrams”)	US 6,826,512 B2	Nov. 30, 2004
Aizu et al. (“Aizu”)	US 6,838,978 B2	Jan. 4, 2005
Sitnik	US 6,988,276 B2	Jan. 17, 2006

D. The rejections

The Examiner agrees (Answer 3, para. 6) that the grounds of rejection before us are correctly stated in the Brief as follows:

Claims 1, 3-5, 9, 12, 15, 18-23, 25, 26, 28, 29, and 31 stand rejected under 35 U.S.C. § 103(a) for obviousness over Smyers in view of Sitnik and Klosterman. (Br. 14.)

Claims 2, 11, 13, 16, and 17 stand rejected under § 103(a) for obviousness over Smyers, Sitnik, and Klosterman further in view of Dara-Abrams (identified in the Brief as U.S. Patent 6,852,512). (*Id.* at 15.)

Claims 8, 10, 24, and 30 stand rejected under § 103(a) for obviousness over Smyers, Sitnik, and Klosterman further in view of Aizu. (*Id.* at 16.)

E. Claim grouping

Appellant argues independent claims 1, 9, and 15 as a group. (Br. 17-24). We select claim 1 as representative of these claims. 37 C.F.R. § 41.50(c)(1)(vii) (2009).

THE ISSUE

Appellant has the burden on appeal to show reversible error by the Examiner in maintaining the rejection. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.” (citation omitted)).

The principal issue before us is whether Appellant has shown that the Examiner erred in concluding that it would have been obvious to combine the teachings of Smyers (with the monitor being implemented as a TV receiver) with those of Klosterman in a way that satisfies claim 1.

ANALYSIS

Smyers discloses a monitor for an IEEE 1394 home network. Smyers, col. 1, ll. 6-10. An example of such a home network can include a central controller that turns on a Set Top Box (STB) and a VCR at a pre-programmed time to record a program. *Id.* at col. 1, ll. 15-18.

Smyers’s invention comprises a network monitor, including a device for obtaining information by monitoring the state of devices in a 1394 home network, and means for storing the obtained information. *Id.* at col. 1, ll. 37-41.

Figure 1 of Smyers is reproduced below.

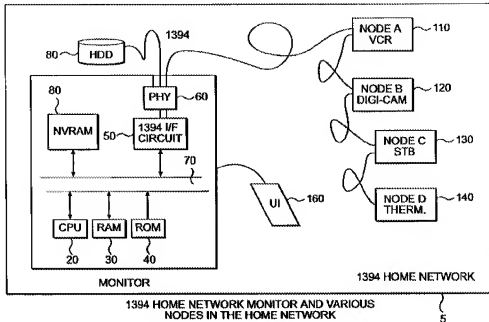


FIG. 1

Figure 1 is a block diagram of Smyers's 1394 home network monitor (unnumbered) connected to a 1394 home network. *Id.* at col. 1, ll. 52-54. The home network has multiple nodes, shown in Figure 1 as a VCR 110, a digital camera 120, a set top box (STB) 130, and a thermometer 140. *Id.* at col. 2, ll. 9-12. By means of a "user interface 60 [sic: 160]," a user can instruct the monitor 10 to monitor the states of the various nodes in the 1394 home network and record the information in the storage means 80. *Id.* at col. 2, ll. 34-37. When a home user so desires, he or she can examine the information log stored in storage 80. *Id.* at col. 2, ll. 52-53.

When comparing Smyers to claim 1 as it read prior to its above-noted revision to include the limitations of claim 7, the Examiner found that Smyers discloses all of the claimed subject matter except using a television

receiver as the monitor and relies on Sitnik for such a teaching, citing Sitnik's discussion of in-home networks at column 1, lines 25-36, under the heading "Background of the Invention." Final Action 4-5. During oral argument, counsel for Appellant conceded the obviousness of implementing Smyers's monitor as a television receiver. We therefore find it unnecessary to consider whether the Examiner erred in relying on Sitnik for such a teaching.

For a teaching of the "BLOCK function" limitations added to claim 1 from claim 7, the Examiner relies on Klosterman. Klosterman's disclosed invention relates generally to television systems, and more particularly, to the interception of television programming signals tuned by a television and the replacement or overlay of said tuned television programming signals with alternative video and/or audio programming and/or with graphics and/or text. Klosterman ¶ 0002. Specifically, Klosterman's invention provides methods and systems to replace and/or modify the advertisements that can be seen and heard by the television viewer. *Id.* ¶ 0010.

One of Klosterman's disclosed embodiments employs a "blocking" function. Specifically, in one embodiment of an EPG (Electronic Program Guide⁶) implementation, Klosterman's invention relies on an audio blocking bit ("ABB") and/or a video blocking bit ("VBB") of the channel ID entries in the channel data table and on the "show list" entries in the show list data structures depicted in Figures 2A and 2B in order to determine whether to

⁶ Klosterman ¶ 0008.

block the video and/or audio signals currently tuned by the viewer's television set. *Id.* ¶ 0060. If either of audio and visual blocking is activated, the system can access an advertising database according to a preprogrammed set of instructions dependent upon criteria such as the time of day, the day of the week, the type of program that the viewer was watching immediately before activating the EPG, and/or the channel to which the viewer was tuned immediately before activating the EPG. *Id.* ¶ 0063. The preprogrammed set of instructions determines the appropriate replacement advertisement to display in the appropriate window and/or windows of the EPG display. *Id.*

The Examiner, after characterizing Klosterman's system as "allow[ing] television programming signals to be received or stored in the receiver device while the display of the signal is blocked from view or replaced with alternative graphics and/or text" (Final Action 16), concluded that

[i]t would therefore be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Smyers'[s] invention, with the feature of a master device that includes a capability to activate a message BLOCK function which prevents messages sent from the at least on slave device from being displayed, and wherein the memory cumulatively stores the operation status data included in each response signal, regardless of whether a message BLOCK function of the master device is currently activated or not, as disclosed by Klosterman, for the motivation of blocking out undesired or unwanted television signal programs (i.e., commercials and advertisements) according to viewer preferences [0003-0006].

Id. at 17 (emphasis omitted) (third brackets in original). We understand the Examiner to be proposing to use a blocking function like Klosterman's in Smyers for the purpose of blocking the display of data obtained from Smyers's nodes (e.g., VCR 110, digital camera 120, set top box (STB) 130, and thermometer 140). We agree with Appellant that, even assuming for the sake of argument that an artisan would have considered Klosterman to be analogous prior art, the effect of modifying Smyers in this way would be to block display of the historical data, which is the only type of data Smyers describes as being displayed, thereby rendering Smyers inoperative for its intended purpose. *See In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (not obvious to modify a prior art device if the modification would render the device inoperative for its intended purpose). Specifically, Appellant argues that

the statement that one would be motivated to block Smyers'[s] operational history displays, which a user explicitly wants to display in Smyers, is counterproductive and, would effectively frustrate a user of Smyers'[s] system by blocking the very operational history reports that user has asked for. This is an example of where the proposed modification of Smyers by Klosterman would result in an inoperative device in the sense that Smyers would be precluded from operating as intended.

(Br. 23.) We note that the Examiner has not provided a response to this argument by Appellant.

For the foregoing reasons, the rejection of independent claims 1, 9, and 15 for obviousness over Smyers in view of Sitnik and Klosterman is

reversed, as is the rejection on the same ground of dependent claims 3-5, 12, 18-23, 25, 26, 28, 29, and 31.

The rejection of dependent claims 2, 11, 13, 16, and 17 for obviousness over Smyers, Sitnik, and Klosterman in view of Dara-Abrams is reversed because Dara-Abrams does not cure the above-noted deficiencies in the other three references.

Similarly, the rejection of dependent claims 8, 10, 24, and 30 for obviousness over Smyers, Sitnik, and Klosterman in view of Aizu is reversed because Aizu does not cure the above-noted deficiencies in the other three references.

CONCLUSION OF LAW

The Examiner's rejections of claims 1-5, 8-13, 15-26, and 28-31 under 35 U.S.C. § 103(a) for obviousness over the cited prior art are reversed.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we are entering the following new ground of rejection against claim 1.

Claim 1 is hereby rejected under 35 U.S.C. § 103(a) for obviousness over the subject matter described in paragraphs 0004 and 0005 in the "Discussion of the Related Art" portion of Appellant's Specification in view of Smyers.

A statement by an applicant during prosecution identifying certain matter not the work of the same inventor as “prior art” is an admission that the matter is prior art. *Riverwood Int’l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354 (Fed. Cir. 2003). Such an admission can be relied on as support for a rejection under 35 U.S.C. § 103(a). See *In re Nomiya*, 509 F.2d 566, 570-71 (CCPA 1975) (“We see no reason why appellants’ representations in their application should not be accepted at face value as admissions that Figs. 1 and 2 may be considered ‘prior art’ for any purpose, including use as evidence of obviousness under § 103.”). Furthermore, a person is barred by 35 U.S.C. § 102(f) from obtaining a patent on that which is obtained from someone else whose possession of the subject matter is inherently “prior.” See *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1401 (Fed. Cir. 1997) (“Section 102(f) provides that a person shall be entitled to a patent unless ‘he did not himself invent the subject matter sought to be patented.’ This is a derivation provision, which provides that one may not obtain a patent on that which is obtained from someone else whose possession of the subject matter is inherently ‘prior.’”). Derivation of an invention from the work of another can be applied as § 102(f) prior art in a rejection based on §§ 102(f) and 103. *Id.* at 1403-04 (“[S]ubject matter derived from another not only is itself unpatentable to the party who derived it under § 102(f), but, when combined with other prior art, may make a resulting obvious invention unpatentable to that party under a combination of §§ 102(f) and 103.”).

As noted above, Appellant’s paragraph 0004 explains that “[i]n general, a *typical* home network system includes a master device and a

plurality of slave devices,” that “some of the *typical* master devices are a television (TV) receiver, a personal computer (PC) and an Internet-ready refrigerator,” and that “[t]he master appliances *have* a memory for sharing information with slave [sic: slave] devices connected in a network.”

Specification ¶ 0004 (emphasis added). The terms “typical” and “have” in this paragraph suggest that the use of a TV receiver as a master device in a home network system and the provision of a master device with a memory were not invented by Appellant and thus constitute prior art with respect to Appellant’s claimed invention.

Likewise, the characterization of the BLOCK function described in paragraph 0004, reproduced (again) below, as “known” suggests that the BLOCK function, too, is prior art with respect to Appellant’s claimed invention:

In such [a] home network system, when a slave device receives a status request signal from the master device, it always sends a response signal (e.g., a message or event signal) back to the master device. Therefore, when a large number of slave devices are connected to the network and are in operation, the master device may have problems in properly receiving and displaying all the message or event information sent by all the slave devices. Due to this reason, a user may be greatly disturbed when trying to use or operate the master device. One of the *known* functions for eliminating this overload problem is a BLOCK function, which may be activated in the master device for not displaying (blocking) the message signals sent by the slave devices for a predefined period of time.

Id. ¶ 0005 (emphasis added). Appellant has not filed a declaration or affidavit under 37 C.F.R. § 1.132 asserting that the subject matter described

in paragraphs 0004 and 0005 was invented by Appellant and thus does not constitute prior art with respect to Appellant's claims. See *Riverwood*, 324 F.3d at 1355 ("One's own work may not be considered prior art in the absence of a statutory basis . . ."). Under these circumstances, it is appropriate to treat that subject matter of paragraphs 0004 and 0005 as admitted prior art and/or as prior art under 35 U.S.C. § 102(f). That subject matter is hereinafter referred to as the "admitted prior art."

Comparing claim 1 to the admitted prior art, the differences are: (1) the television receiver in the admitted prior art is not described as "repeatedly" sending status request signals to at least one a slave device; and (2) the memory in the television receiver is not described as "cumulatively stor[ing] the operation status data included in each response signal even when the message BLOCK function of the television receiver is currently activated." As explained above, Smyers discloses using the monitor 10 to monitor and record the states of the various nodes in a storage log 80 of a home network (Smyers, col. 2, ll. 34-37) so that "[w]hen a home user so desires, he or she can examine the information log stored in storage 80." *Id.* at col. 2, ll. 52-53. Furthermore, the monitoring and recording can be programmed to occur repeatedly. For example, the controller can be programmed to examine the temperature measured by thermometer 140 every thirty minutes. *Id.* at col. 2, ll. 37-41.

We conclude that it would have been obvious to modify the admitted prior art so to include Smyers's disclosed recording and subsequent log playback capabilities. It also would have been obvious to record the

monitored values for later log playback even if the BLOCK function has been activated by the user, thereby preventing immediate display of those values. This combination of reference teachings comports with the *KSR* principle that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). *See also id.* (“[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

Although we have not entered a new ground of rejection based on the above prior art against any of the remaining claims pursuant to our discretionary authority under 37 C.F.R. § 41.50(b), that does not mean we have determined that the remaining claims are patentable over that prior art. Rather, we leave the patentability determination regarding these claims to the Examiner. *See* MPEP § 1213.02.

Regarding the new ground of rejection pursuant to 37 C.F.R. § 41.50(b), that paragraph explains that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Appellant, within *two months* from the date of this decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so

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rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

37 C.F.R. § 41.50(b) (2009).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(v) (2009).

REVERSED; 37 C.F.R. § 41.50(b)

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